

REMARKS

In response to the Office Action of May 27, 2005, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-30 are pending in this application. By this Amendment, Claims 1, 20 and 26 have been amended. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has objected to the Abstract for the inclusion of legal phraseology. The Abstract has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has objected to the specification for certain informalities, namely, including the serial numbers and filing dates of the referenced patent applications on page 21, 25, 20 and 27. The specification has been amended in a manner believed to obviate the Examiner's objections. Accordingly, withdrawal of the objections is respectfully requested.

The Examiner has objected to Claim 1 for the recitation "is provided". Claim 1 has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has rejected Claims 20-30 under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has rejected Claim 20 for the recitation “the lubricating oil composition property data” and Claim 26 for the recitation “the computer” as lacking antecedent basis. Claims 20 and 26 have been amended in manner believed to obviate the rejection. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 20, 22 and 23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 13, 14 and 21 of co-pending Application No. 10/699,510. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 20 and 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 2, 13-18, 20-22 and 33-38 of co-pending Application No. 10/699,507. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 20, 22-24 and 26-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-3 and 10-14 of co-pending Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 17 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 13, 14 and 21 of co-pending Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 1-3, 8-11 and 16-19 under 35 U.S.C. §102 (e) as being anticipated by Carey et al. U.S. Patent Application Publication No. 2004/0144355 ("Carey").

Nowhere does Carey disclose or suggest a "combinatorial lubricating oil composition library comprising a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) at least one lubricating oil additive" as presently recited in Claim 1. Nor, for that matter, does Carey disclose or suggest a "combinatorial lubricating oil composition library ... further comprising lubricating oil composition property data for each of the different lubricating oil compositions" as presently recited in Claim 17.

Rather, Carey discloses a marine diesel engine system containing a slow-speed cross head marine diesel engine with at least one cylinder; cylinder lubricant components proximate to the engine and selected from (i) an alkylamine-alkylphosphate having at least 1.25 equivalents of alkylamine to 1.0 equivalents of alkylphosphate, (ii) 500 TBN calcium sulfonate, and (iii) mixtures thereof; and means for blending the primary lubricant and additive into a mixture for introduction into the cylinder when engine conditions require the mixture. Carey further discloses storage stability data of a series of oil compositions that were obtained by storing the samples at a temperature and time period (shown in Table II of Carey) until a noticeable amount

of sediment or floc appeared and then measuring the volume percent of such precipitate.

However, it is well established that for a claim to be anticipated a single prior art reference must disclose each and every element of the claimed invention. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987). At no point is there any disclosure in Carey of any combinatorial lubricating oil composition library. Instead, Carey merely discloses a list of additives and their amounts used with a marine oil and storage stability data in Table II of its disclosure. As such, Claims 1-3, 8-11 and 16-19 clearly recite novel subject matter over Carey.

The Examiner has rejected Claims 4-7 and 12-15 under 35 U.S.C. §103 (a) as being obvious over Carey.

The foregoing deficiencies of Carey discussed above with respect to the rejection of Claim 1, from which Claims 4-7 and 12-15 ultimately depend, apply with equal force to this rejection. At no point is there any suggestion, motivation or even a hint in Carey of providing a combinatorial lubricating oil composition library. Instead, Carey is merely concerned with modifying lubricant properties depending upon marine engine conditions and not at all with forming combinatorial lubricating oil composition libraries. Accordingly, Claims 4-7 and 12-15 are believed to be nonobvious, and therefore patentable, over Carey.

The Examiner has rejected Claims 20-26 under 35 U.S.C. §103 (a) as being obvious over Carey in view of Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 ("Kolosov").

Nowhere does Carey disclose or suggest a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising (a) providing a library of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b) as presently recited in Claim 20.

Rather, Carey discloses a marine diesel engine system containing a slow-speed cross head marine diesel engine with at least one cylinder; cylinder lubricant components proximate to the engine and selected from (i) an alkylamine-alkylphosphate having at least 1.25 equivalents of alkylamine to 1.0 equivalents of alkylphosphate, (ii) 500 TBN calcium sulfonate, and (iii) mixtures thereof; and means for blending the primary lubricant and additive into a mixture for introduction into the cylinder when engine conditions require the mixture. Carey further discloses storage stability data of a series of oil compositions that were obtained by storing the samples at a temperature and time period (shown in Table II of Carey) until a noticeable amount of sediment or floc appeared and then measuring the volume percent of such precipitate. Nothing in Carey even remotely suggests a high throughput method for producing a combinatorial lubricating oil composition library under program control by providing a library of a plurality of different lubricating oil composition samples in a respective one of a plurality of test receptacles; measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and outputting the results. Thus,

nothing in Carey would lead one skilled in the art to modify the marine diesel engine system disclosed therein and arrive at the claimed high throughput method for producing a combinatorial lubricating oil composition library under program control by providing a library of a plurality of different lubricating oil composition samples in a respective one of a plurality of test receptacles; measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and outputting the results.

Kolosov fails to cure the deficiencies of Carey. Specifically, nowhere does Kolosov disclose or suggest a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising (a) providing a library of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b) as presently recited in Claim 20.

Rather, Kolosov discloses a system and method for screening a library of a multitude of genera of material samples for rheological properties. The genera of material disclosed in Kolosov which can be tested include polymeric materials, organic materials, amorphous materials, crystalline materials, macromolecular materials, small-molecule materials, inorganic materials, pure materials, mixtures of the materials, any commercial product itself or an ingredient or portion within a commercial product such as pharmaceuticals, coatings, cosmetics, adhesives, inks, foods, crop agents, detergents, protective agents, and lubricants, as well as gels,

oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, and emulsions.

In addition to testing the rheological properties of the broad categories of flowable material, Kolosov discloses that other properties may be tested and includes a large number of broad tests such as density, melt index, thermal degradation, aging characteristics, weight-average molecular weight, number-average molecular weight, viscosity-average molecular weight, peak molecular weight, approximate molecular weight, polydispersity index, molecular-weight-distribution shape, relative or absolute component concentration, conversion, concentration, mass, hydrodynamic radius, radius of gyration, chemical composition, amounts of residual monomer, presence and amounts of other low-molecular weight impurities in samples, particle or molecular size, intrinsic viscosity, molecular shape, molecular conformation, and/or agglomeration or assemblage of molecules. According to Kolosov, any of the genera of flowable material can be subjected to any of the plurality of tests disclosed.

However, at no point is there any appreciation in Kolosov of a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising (a) providing a library of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, by measuring the lubricating oil composition properties of each sample; and outputting the results. Thus, nothing in Kolosov would lead one skilled in the art to modify the marine diesel engine system of Carey by looking to the disclosure of Kolosov and arrive at the specifically recited high throughput method of Claim 20.

In order to meet the burden of a *prima facie* obviousness rejection, the Examiner alleges that “[b]ased upon the combination of Carey et al. and Kolosov et al., it would have been obvious to one of ordinary skill in the art to place the plurality of lubricating oil compositions containing additives therein taught by Carey et al. in a plurality of test reservoirs that form a combinatorial array since Kolosov et al. teach that it is advantageous to test a plurality of lubricants containing additives therein in an array format using combinatorial chemistry techniques because the combinatorial approach can effectively evaluate a much larger number of diverse compounds in a much shorter period of time.” However, it is well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. As is the case here, Carey provides no such suggestion, motivation or even a hint of a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising (a) providing a library of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, by measuring the lubricating oil composition properties of each sample; and outputting the results. Thus, one skilled in the art would not look to the disclosure of Kolosov to modify the marine diesel engine system of Carey and arrive at the specifically recited high throughput method of Claim 20. Accordingly, Claims 20-26 are believed to be nonobvious, and therefore patentable, over Carey and Kolosov, no matter how these references are considered or combined.

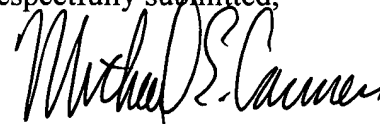
Appln. No. 10/699,529
Amdt. dated August 26, 2005
Reply to Office Action dated May 27, 2005

The Examiner has rejected Claims 27-30 under 35 U.S.C. §103 (a) as being obvious over Carey in view of Kolosov and further in view of Smrcka et al. EP 1 233 361 ("Smrcka").

The foregoing deficiencies of Carey and Kolosov discussed above with respect to the rejections of Claim 20, from which Claims 27-30 ultimately depend, apply with equal force to this rejection. Smrcka does not cure and is not cited as curing the above-noted deficiencies of Carey and Kolosov. Rather, Smrcka is merely cited for its disclosure of storing test results in a data carrier. Accordingly, Claims 27-30 are believed to be nonobvious, and therefore patentable, over of Carey, Kolosov and Smrcka.

For the foregoing reasons, Claims 1-30 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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